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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,056	12/05/2000	James F. Kramer	A-65053-3/RMA	8010

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EXAMINER

WINGOOD, PAMELA LYNN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 05/12/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/730,056

Applicant(s)
Kramer

Examiner
Pamela Wingood

Art Unit
3736



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2.3.03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-36 is/are pending in the application.
- 4a) Of the above, claim(s) 21-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 16, 20, 35, and 36 is/are rejected.
- 7) ☒ Claim(s) 15 and 17-19 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

Pamela Wingood

DETAILED ACTION

Applicant will note the claims being prosecuted are those the elected invention 9-20. The newly presented claims are also being prosecuted because they are drawn to the same invention; however, they are improperly numbered 21 and 22; these numbers already existed in the case. These claims should be presented as 35 and 36. They will be so treated.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 36 is rejected as being directed to non-statutory subject matter. It is a computer program not encoded on a claimed computer-readable medium so as to become a computer element defining structural and functional interrelationships between the computer program and the rest of the computer permitting the program's functionality to be realized. (MPEP 2106,IV,B,1(a))

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9, 10, 20 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Levine.

Levine discloses a finger worn graphics interface device having a mount (24) in the shape of a ring coupled to an appendage (18), a position sensor element (22) including actual sensing layers (Fig. 4) coupled to the mount (Fig. 2), and a support structure at ring (10) to apply a force with stylet point (12). The electronic module (32) is used to obtain the data from sensor element and the sensing layers (Fig. 4) to present the data to a computer supplied with a processor to process signals from the layers and output the data and presenting the results on a X-Y coordinate system to yield absolute coordinates of the sensing element (Col. 7, lns.50-60). It should be noted that the last calculation is inherent as it is embedded in the computer because the results appear on the screen.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Zimmerman..

Levine discloses the limitations above but does not disclose the ring including an elasticized band.

Zimmerman discloses a glove used for data entry using an elasticized material in an analogous art for the purpose of maintaining a close fit of the device on the finger. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ring of Levine as shown by Zimmerman because the tight fit of the ring would allow different sized people to use the device and maintain the integrity of the cursor position by

ensuring a snug fit of the device.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Goldberger et al.

Levine discloses the limitations above but does not disclose a clip having flexible and separable portions.

Goldberger et al. discloses a device having a clip in an analogous sensing art having a flexible spring (54,56) and a separable part seen at Figure 3, such that the finger may be secure in the measurement device for the diagnostic procedure. It would have been obvious to one of ordinary skill in the art at the time the invention was made to alternatively have used in Levine a clip as shown by Goldberger et al because it too would ensure secure gripping of the users finger to ensure proper measurement of position. Here the use of the clip and the ring are both meant to secure the sensor to the finger and are functional equivalents. Without a showing of criticality there will be no patentable weight given to the ring.

8. Claim 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of Tan et al.

Levine discloses the limitations above but does not disclose the use of a thimble.

Tan et al disclose a thimble shaped device in an analogous body mount art for the purpose of maintaining a sensor in close contact with the tip of a finger. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the ring of Levine as shown by Tan et al. because the thimble structure like the elasticized ring would allow different sized people to use the device and maintain the integrity of the cursor position by ensuring a snug fit of the device.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Levine in view of

Kuipers (565).

Levine discloses the limitations above but does not disclose the use of electromagnetic radiation to sense the position of the device.

Kuipers (565) discloses a object tracking device using a generating coil and a sensing coil and a resolver to sense the position of remote a object. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Levine as shown by Kuipers (565) because the use of electromagnetic radiation for track the appendage is effective as an alternative to determine the position of an object. Here the use of the use of a different technology meant to locate the finger and are functional equivalents. Without a showing of criticality there will be no patentable weight given to the method of Levine.

Allowable Subject Matter

10. Claims 15, 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: Prior art of record does not disclose the combination of a system coupled to an appendage positioning system having a multiple sensing elements or the fingernail attachment of Claim 15.

Response to Arguments

12. Applicant's arguments with respect to claims 9-20 have been considered but are moot in view of the new ground(s) of rejection.

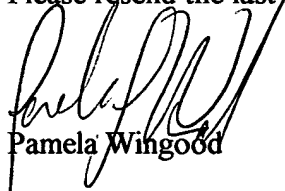
Examiner applied the new reference Levine with the combination of references to anticipate and make obvious the above noted claims. Applicant argues on p. 5 of the amendment

that the prior art did not show the position with respect to a reference point. The new Levine reference is capable of showing the absolute position of the finger on the screen (Col. 7, lns. 50-55) by using coordinates. Furthermore the combination of other references make obvious the use of an elasticized ring, a clip and a finger thimble. Applicant will note the above allowability.

13. Applicant will note that the election has been made final and may thus consider canceling the non-elected claims (21-34) to facilitate prosecution.

Any questions related to this application can be addressed to Pamela Wingood who can be reached on (703)308-2676 on Monday-Thursday and on alternate Fridays.

Please resend the last three documents on the IDS of September 2002.



Pamela Wingood

Patent Examiner

May 5, 2003